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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/366,896	08/04/1999	PAUL NORMAN BURGESS	42430-10030	3637

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Jenner & Block, LLC
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11/18/2003

EXAMINER

DEANE JR, WILLIAM J

ART UNIT	PAPER NUMBER
2642	9

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/366,896

Applicant(s)

BURGESS, PAUL NORMAN

Examiner

William J Deane

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 9 and 11 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,081 (Leskinen).

With respect to claims 1 and 9, Leskinen teaches the claimed device and method as shown at Col. 3, line 22 – Col. 4, line 9, see also the abstract and claim 1).

Note that the device is only for outgoing calls (Col. 3, lines 11 – 15 and Col. 4, lines 35 – 39).

With respect to claims 11 and 12, such is inherent from the above.

Therefore, Leskinen teaches the claimed device except explicitly teaching that the device inhibits incoming calls. However, it appears that such is contemplated as there is no discussion of incoming calls, but only discussions of outgoing calls as shown above. Therefore, such would have been obvious to one of ordinary skill in the art that having only a user ID and no telephone number would inhibit incoming calls. In addition, see Response to Arguments below.

Claim 2 - 4, 6 - 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leskinen in view of U.S. Patent No. 5,722,067 (Fougnyes et al.).

With respect to claim 2 - 4 and 6 - 8, Leskinen teaches the claimed device except for assigning a currently assigned telephone number with the communications device for billing using ANI.

Fougnies et al. teach using ANI for billing purposes to a predetermined or pre-selected number (see Abstract, Summary of the Invention and claims). There is no reason why the pre-selected number could not already be a currently assigned number e.g. an office or home number with a prepaid account. It would have been obvious to one of ordinary skill in the art to have provided the Leskinen device and method ANI for billing purposes to an assigned number as taught by Fougnies et al. as such would only entail the substitution of one smart card for another.

With respect to claim 3, one a number is associated with a telephone number it would have been obvious to one of ordinary skill to use the association for maintenance billing and etc.

With respect to claims 7 and 10, obviously once the account is canceled the pre-selected number would be reused. With respect to claim 10 note Col. 4, lines 13 – 18. It would have been obvious to have provided the Leskinen device and method with the ability to assign temporary numbers as taught by Fougnies et al. in order for the Leskinen device to receive a incoming calls.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leskinen in view of Fukuzawa et al.

Leskinen teaches the claimed device except for the temporary assigning of unassigned telephone numbers in which the assigning of temporary numbers is initiated by a phone

call. However, Fukuzawa et al. teach such limitations (see Abstract, Summary of Invention and Claim 1). It would have been obvious to one of ordinary skill in the art to have provided the Leskinen device and method with the ability to initiate usage of a temporary number via phone call as taught by Fukuzawa et al. in order to receive incoming calls. In addition, note Col. 6, lines 53 – 56.

With respect to claims 19 – 26 such claims would be rejected in a like manner to the claims above. The claims, 19 – 26, are only differentiated by claiming the assigning of a telephone number to a line rather than to a device. However, such would have been obvious to one of ordinary skill in the art in light of the Leskinen reference. With such things as dedicated lines, it would have been obvious to assign a telephone number to a line just like assigning it to a device.

Response to Arguments

Applicant's arguments with respect to claims 1- 12 and 19 - 26 have been considered but are deemed persuasive to any error in the above rejections.

Applicant's main argument is that Leskinen does not teach or disclose the ability to inhibit incoming calls. It is true that Leskinen does not explicitly teach or disclose inhibiting incoming calls, but such can be inferred from a fair reading of Leskinen. One teaching of Leskinen is to have a phone that one seldom uses and one that allows a user to switch teleoperators when desired and to be unidentified to a Network and what ever ID is given such is temporary (Col. 3, lines 5 - 18 and lines 22 - 27). How could one make an incoming call under these conditions? A caller to the user would not know

the user's number. Even if the a user gave a caller a number to call- back (which does not appear to be possible) the invention could still be said to inhibit calls. That is, if incoming calls were possible, some incoming calls would be inhibited. For example, if a user using the Leskinen device misdialed and got a wrong number the user's number would not show a Caller ID at the wrongly called device. Even if a caller ID was shown at the wrongly called device, and a user has the ability to change his ID and teleoperators dynamically, such inhibits incoming calls. It is also fair to believe that even if incoming calls are possible, the user could inhibit such by simply removing the SIM or smart card.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306-5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 872-9314.

14Nov03



WILLIAM J. DEANE, JR.
PRIMARY EXAMINER